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OFFICE OF PETITIONS

In re Application of :
Snell et al. : DECISION ON PETITION
Application No. 10/005,483 :
Filed: 9 November, 2001 :
Atty Docket No. 56162.000489 :

This is a decision on the petition under 37 CFR 1.47(a) filed on 17 April, 2005, which is being treated as a petition under 37 CFR 1.183, seeking waiver of 37 CFR §§ 1.67 and 1.175 where it requires that a supplemental declaration be executed by a named inventor.¹

The petition is before the Office of Patent Legal Administration for decision.

The petition is **DISMISSED**.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. **FAILURE TO TIMELY RESPOND WILL RESULT IN ABANDONMENT OF THE APPLICATION.** The reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.183."

REVIEW OF FACTS

1. On 9 November, 2001, the application was filed as an application for reissue of U.S. Patent No. 5,982,807.

¹ Once an application has received a fully executed oath or declaration and been placed on the files for examination, the provisions of 37 CFR 1.47 no longer apply. Rather, the remedy for treating an inventor's refusal to also sign a supplemental oath or declaration is waiver of 37 CFR 1.67. See MPEP 603.

2. On 28 February, 2003, a renewed petition under 37 CFR 1.47(b) filed on 10 February, 2003, was granted with respect to joint inventors James Leroy Snell, Carl F. Andren, and Leonard Victor Lucas.

3. On 29 April, 2005, a final Office action was mailed, setting a three (3) month shortened statutory period for reply.

4. On 29 September, 2005, a Notice of Appeal was filed, accompanied by a two (2) month extension of time, and an amendment after final rejection.

5. On 22 November, 2005, an Advisory Action was mailed, stating that the period for reply expired five (5) months after the mailing of the final Office action.

6. Also on 22 November, 2005, an Interview Summary was mailed, setting a one (1) month period for reply.

7. On 31 March, 2006, an amendment was filed, accompanied by a supplemental declaration naming only inventor Snell.

8. On 17 April, 2006, the present petition was filed, stating that previously signing inventor Lucas could not be located to sign the supplemental declaration.

9. On 29 April, 2006, an amendment paper was filed. The amendment paper included an authorization to charge all required fees, that is appropriate for treatment as a constructive petition for an extension of time as needed for a timely submission. See 37 CFR 1.136(a)(3).

10. On 5 May, 2006, the examiner issued an *Ex parte Quayle* Office action, setting forth the need for a supplemental declaration (which is the subject of the instant petition).

DECISION ON PETITION UNDER 37 CFR 1.183
TO WAIVE §§ 1.67 AND 1.175

Petitioners state that a copy of the supplemental declaration under 37 CFR 1.175 was sent to joint inventor Lucas by Federal Express; however, petitioners were informed that the address provided for Lucas was not correct.

Suspension of the rules under 37 CFR 1.183 may be granted in an "extraordinary situation, when justice requires." The facts presented on the record do not adequately establish an extraordinary situation. Petitioners have not sufficiently established special circumstances of equities that would require suspension of the rules in the interests of justice.

This application bears an original Declaration executed by joint inventor Lucas and Andren, and 37 CFR 1.47(a) status was granted with respect to joint inventor Snell on 28 February, 2003. Thus, the provisions of 37 CFR 1.47 do not apply in this instance. Nevertheless, it is appropriate to apply the principles for a showing under 37 CFR 1.47 to the situation at hand. Since joint inventor Lucas signed the original declaration, petitioners must show that efforts were made to obtain inventor Lucas' signature on the supplemental declaration.

Petitioners' showing is deficient in that proof of diligent efforts to locate the non-signing inventors has not been made.²

Specifically, the showing of record is that the declaration and application papers were sent to inventor Lucas at "1706 SE Sedgwick." However, the street address listed for him on the Kitsap County tax assessor's statement is "7106 SE Sedgwick." As such, it is clear that the digits of the street address were transposed, and that an incorrect address was used. In order to complete the showing, petitioners must re-send the declaration and application papers to the correct address, with a request that joint inventor Lucas sign and return the supplemental declaration. If joint inventor Lucas refuses to sign the declaration, petitioners should provide a copy of the cover letter transmitting the supplemental declaration to the non-signing inventor or details given in an affidavit or declaration of facts by a person having first-hand knowledge of the details.

Additionally, no copy of the reissue declaration listing the names of all of the inventors and signed by the signing inventors has been provided. A proper reissue declaration in compliance with 37 CFR 1.175 should be provided with any renewed petition.

CONCLUSION

1. The petition is dismissed. As a petition under 37 CFR 1.183 to waive 1.175 is required rather than a petition under 37 CFR

² MPEP 409.03(d).

1.47, the petition fee due is \$400.00. The balance due of \$200.00 will be charged to counsel's deposit account.

2. Further correspondence with respect to this matter should be addressed as follows:


By mail: Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

By FAX: (571)273-8300
Attn: Office of Petitions

By hand: Customer Service Window
Mail Stop Petition
Randolph Building
401 Dulany Street
Alexandria, VA 22314

3. Telephone inquiries related to this decision only should be directed to Senior Petitions Attorney Douglas I. Wood at (571) 272-3231.

4. Inquiries regarding petition status or general petition information are handled by the Office of Petitions staff at (571) 272-9282.



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